

REMARKS

Claims 1-3, 5, 8-14, 16, 19 and 20 are pending, and claims 1 and 11 have been amended to clarify the invention. No new matter has been added by the aforementioned changes.

Considering first the objection under 35 USC §132(a), the Examiner takes the position that the phrase “capable of holding information regarding the location of the receiver” is not supported by the original disclosure. The objection is in error.

The original disclosure makes several references to the ability of the invention to hold information regarding the location of the receiver. In the original disclosure it is described that the memory may be utilized to store “a respective reference code pertaining to a particular mother located in a room next to the receiver.” (Specification at page 7, lines 5-7). The original disclosure also describes that the invention is capable of locating an infant’s true mother in a room shared by a plurality of new mothers. (Specification at page 10, lines 3-8). The original disclosure also describes that the invention is capable of automatically recalibrating to another room if the baby’s mother is moved to another room. (Specification at page 14, lines 1-7). Furthermore, Figure 3 of the original disclosure illustrates an infant proceeding along the corridor whereby the Applicant’s invention alerts to the location of the true mother. Thus, the original specification supports the claimed feature of a “programmable memory for storing said unique reference code and for holding information regarding the location of said receiver.”

Turning to the art rejections, and considering first the rejection of claims 1-3, 5, 8-11, 16 and 19-20 as obvious from Murray et al. in view of Davies, as noted in Applicant’s previously filed Appeal Brief, which is incorporated herein by reference, the primary reference, Murray et al., teaches a mobile perimeter monitoring system comprising a two unit system

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composed of a mobile transmitter having a predetermined range, and a receiver having an alarm signal and a mode switch which places the receiver in either a monitoring mode (if the receiver moves beyond the transmitter's range, an alarm will sound) or a tracking mode (if the receiver is within the transmitter's range, an alarm will sound). (Column 1, lines 56-62). An example of the disclosed invention is that of a child monitoring system wherein a parent or guardian would be alerted by an alarm should the child move beyond a predetermined area.

The secondary reference, Davies teaches a system for monitoring the presence of a person at a monitoring location, e.g., for monitoring persons subject to house arrest. The system is composed of three components: (1) a plurality of local monitoring units 10a, 10b..., each incorporating a transmitter, and associated with one monitoring location; (2) a plurality of "tags" 12a, 12b... (containing a severance detection circuit) each attached to one person to be monitored; and (3) and a mobile unit 14 incorporating a report signal receiver. The local unit is capable of three functions: (1) it can detect the presence of the person to be monitored (e.g., a parolee); (2) it can detect a nearby mobile unit; and (3) it can transmit presence or non-presence information (the "report signal"). The mobile unit, which can be carried in a vehicle or by a monitoring officer, is capable of detecting the report signal. Specifically, the mobile unit indicates whether it is within range of a local unit report signal, whether it has obtained a report signal, and what the status of the report is (is the monitored person present or not present?). (Column 2, lines 42-68; column 3, lines 1-19 and Fig. 2).

Davies also provides for a "callout signal" to be sent from the mobile unit to initiate a report signal to be sent from the local unit. The callout signal may also produce a perceptible (audio or visual) indication at the local unit which could be used for, among other things, indicating to the monitored person that he is to come to the front of the house. (Column 3, lines

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32-50). The callout signal sent by the mobile unit transmitter must match the local identification code of only one local unit. Mobile units will therefore, interact with only one local unit. (Column 10, lines 67-68; column 11, lines 1-2). The local identification code defines the local unit using four trinary digits. The local unit is designed to test incoming signals and reject all incoming signals that do not have a matching local identification code. (Column 5, lines 30-45).

Thus, the primary reference Murray et al. and the secondary reference Davies are fundamentally different from Applicant's claimed invention and from one another. Murray et al. is a perimeter monitoring system designed to trigger a signal or an alarm when a child or pet wanders outside of a predetermined range. Essentially, Murray et al. is a two unit system comprising a mobile transmitter designed to be worn by a child or pet which provides a signal to a receiver which processes the signal and provides an alarm function should the transmitter move out of range of the receiver. Davies describes a personnel monitoring system designed for monitoring presence of individuals at preselected monitoring locations, i.e. for maintaining control of persons subject to house arrest. Davies' system includes a tag carried by the monitored person; a local unit, at each monitoring location to determine whether the monitored person is present or absent, and a mobile unit for communicating with each local unit for detecting a report signal from the local unit and/or to provide a callout signal to the local unit to instruct the monitored person to present himself for inspection.

Stated another way, the primary reference Murray et al. is a mobile perimeter monitoring system capable of monitoring whether a transmitter and a receiver are within range or beyond range. In other words, in Murray et al., the transmitter and receiver simply provide information regarding a location of one relative to the other. Similarly, Davies' tag and local

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unit also are designed to determine the presence or absence of associated (tagged) person within a predetermined range of a local unit. There is nothing within the four corners of Davies that teaches or suggests that the receiver or local unit have the capacity to store information regarding the location of that unit. Nor is there any reason for Davies to include this capability since Davies' local unit is fixedly located. And, there is no teaching or suggestion within the four corners of Davies that each of the local units have user interfaces configured to program the memory as required by Applicant's independent claims 1 and 11.

At page 3 of the Action, the Examiner seems to take the position that Davies teaches the code being related to the location of the receiver. Applicant respectfully submits that Examiner has confounded "identification code" with "information regarding the location of the receiver." The identification code taught by Davies (See column 5, lines 29-48), is composed of four trinary digits that are used to match a local unit to a mobile unit. "[T]he callout signal sent by transmitter 88 will match the local identification code of only one local unit 10. Mobile unit 14 therefore will interact with only one local unit at a time." (Column 10, lines 67-68; column 11, lines 1-2). In Davies, a local unit is ranged to test incoming signals for its particular identification code and reject all other incoming signals which do not bear this code. In other words, both Murray et al. and Davies are perimeter monitoring devices. The primary reference Murray et al. operates completely independent of location. That is to say, all that Murray et al. is concerned with is in providing an in-range or out-of-range indication depending on whether the receiver is within an effective range of the transmitter or outside of its effective range.

However, information as to actual location is not provided by Murray et al.

Davies similarly provides an in-range or out-of-range implication on a one-to-one match between a fixedly positioned local monitoring unit and a person to be monitored. Davies

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also includes a mobile unit for selectively interrogating or addressing the local monitoring units. Thus, Murray et al. and Davies are quite different in structure and function from one another and from Applicant's claimed invention.

Nowhere does Davies disclose using memory to store location information *in addition to identification codes* as required by independent claims 1 and 11 of Applicant's invention. Nor does Davies teach that each receiver include a user interface configured to program memory as required by independent claims 1 and 11.

As the Examiner is no doubt aware, to establish a *prima facie* case of obviousness based on a combination of references, there must be some teaching, suggestion, or motivation in the prior art to make the specific combination that was made by the Applicant. In re Dance, 48 USPQ2d 1635 (BNA 1998). The Federal Circuit has stated that if a proposed modification to a prior art invention makes it unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01.

According to the Examiner, Murray et al. and Davies can be combined for the purpose of enabling the system to be used with a plurality of independent users and programming an identification code in the memory to correspond to each individual user. However, modifying Murray et al. in this regard would defeat Murray et al.'s intended purpose and utility.

As previously discussed, Davies specifically teaches that mobile units should uniquely correspond to local units via the local identification code. This facilitates officers obtaining status information for a specific parolee rather than information from every local unit about every parolee. Murray et al. by contrast, while mentioning the possible use of multiple transmitters corresponding to multiple children, specifically teaches that such configuration is

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undesirable (Col. 1, lines 43-50). Thus, modifying Murray et al. in view of Davies as suggested by the Examiner would produce a system wherein the parent would need numerous receivers -- one for each child being monitored.

Accordingly, it is respectfully submitted that no combination of Murray et al. and Davies reasonably could be said to achieve independent claim 1 or independent claim 11 or any of the several claims 2, 3, 5, 8-10, 16, 19 and 20 which depend thereon.

The rejection of claims 12-14 as unpatentable under 35 U.S.C. § 103(a) over Murray et al. in view of Davies and further in view of Radomsky et al. likewise is in error.

Claims 12-14 are directly dependent on claim 11. The deficiencies of the combination of Murray et al. and Davies vis-à-vis claim 11 are discussed *supra*. It is submitted that Radomsky et al. does not supply the missing teachings to Murray et al. and Davies to achieve or render obvious claim 11 or any of the claims 12-14 which depend thereon.

Radomsky et al. disclose a dual-bowed (matching and security) transmitter (404) coupled to an identification band (304) coupled to an associated infant. (Fig. 11; column 10, lines 10-30). In a matching mode of operation IR signals are received by infrared receivers located within the various rooms of the hospital to determine by proximity that mother and infant are correctly united. In the presence detecting mode, RF signals from the infant's badge are detected by RF receivers located throughout the maternity ward and/or the hospital to detect RF signals and generate an arm to detect the attempted unauthorized removal of the infant from the maternity ward and/or the hospital (Abstract).

With regard specifically to the rejection of claim 12, the Examiner acknowledges that the combination of Murray et al. and Davies fails to teach or suggest an identification band

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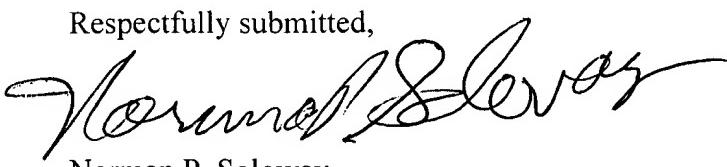
coupled to an associated infant. However, the Examiner relies on Radomsky et al. for this missing teaching. Radomsky et al. teaches a patient matching and security system which includes matching, monitoring and detects unauthorized removal of an infant from the hospital maternity ward and/or the hospital. Radomsky et al. has been cited as teaching a transmitter coupled to an identification band coupled to an associated infant, and is acknowledged as so teaching. However, the more basic and essential combination of features missing from Murray et al. and Davies as required by claim 11 and claim 12 which depends thereon are not provided by Radomsky et al.

Similar comments apply to dependent claims 13 and 14. Accordingly, it is submitted that no combination of Murray et al., Davies and Radomsky et al. reasonably could be said to achieve or render obvious claim 11 or claims 12-14 which depend thereon. Accordingly, the rejection of claims 12-14 as obvious from Murray et al. in view of Davies and Radomsky et al. is in error.

Having dealt with all the objections raised by the Examiner, the Application is believed to be in order for allowance. Early and favorable action is respectfully requested.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account Number 08-1391.

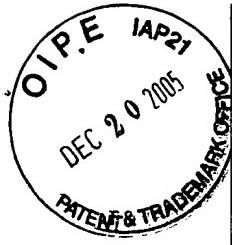
Respectfully submitted,



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